



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:
JENSEN *et al.*

Confirmation Number: 8002

Application No.: 09/855,021

Group Art Unit: 2142

Filed: May 15, 2001

Examiner: S. WILLETT

TITLE: METHOD AND SYSTEM FOR PRIORITIZING NETWORK SERVICES

November 18, 2005

* * * * *

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated October 20, 2005, Applicant hereby provisionally elects Group II, claims 7-21, 34-60 and 67-77. This response to the restriction requirement is made with traverse.

Firstly, Applicant submits that the restriction requirement is improper for failing to meet the criteria for a requirement to restrict. MPEP § 808 states: "Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections." MPEP § 808.02 further states: "The examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) Separate classification thereof; (B) A separate status in the art when they are classifiable together; (c) A different field of search." The Examiner contends that the inventions of Groups I and II have acquired a separate status in the art as shown by their different classification. To support this contention, the Examiner indicates that the Group I is classified in class 709, subclass 242 and Group II is classified in class 709, subclass 240. Subclass 240 relates to means or

steps for transferring the data in accordance with a ranking assigned to the data. Subclass 242 relates to means or steps for periodically exchanging control data indicating how to transfer data among nodes or routes in a network. Both of these subclasses are indented under subclass 238 which relates to means or steps for selecting a path via which the computers will transfer data. Referring to the language of the independent claims, Applicant finds no reason for not classifying Groups I and II under the same class/subclass. For example, without arguing for a particular classification, Applicant fails to understand the rationale for why independent claims 1 and 61 relate to means or steps for periodically exchanging control data indicating how to transfer data among nodes or routes in a network or why those claims could not be classified under subclass 242 or more generally under subclass 238, which encompasses both subclasses 240 and 242. In conclusion, Applicant finds no legitimate reasons or coherent rationale for classifying Groups I and II under subclasses 242 and 240, respectively. Therefore, Applicant respectfully objects to the Examiner's conclusion that Groups I and II each have acquired a separate status in the art as shown by their different classification.

Further, assuming there was proper reasoning for the restriction requirement, it is respectfully submitted that the subject matter of each group is sufficiently related that a thorough search and examination of the entire application can be made without a serious burden and that the criteria for a proper restriction requirement have not been met. MPEP § 803 clearly states that "[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on its merits, even though it includes claims to distinct or independent inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and duplicative examination by the U.S. Patent and Trademark Office. Accordingly, it is respectfully submitted that the restriction requirement is improper and must be withdrawn.

This argument regarding undue burden is particularly apposite in this case as the Examiner has already searched all the claims and issued an Office Action on the substance of those claims. Per MPEP §811, "[b]efore making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." [emphasis added] Applicant respectfully submits there is not a serious burden to examine the present claims, as Examiner already has done so and, if Examiner's classification were correct, there wouldn't be a serious burden to search two subclasses each

of which are indented under another subclass. Further, if this Restriction Requirement is not withdrawn, Applicant demands that the Examiner withdraw the previous Office Action and its rejections of the claims (or otherwise Examiner's position is inconsistent). Moreover, if this Restriction Requirement is not withdrawn, Applicant expressly withdraws all arguments previously made regarding any and all claims that are not elected.

Applicant also notes that the U.S. Patent Office would be required to allow non-elected claims if presented in a divisional application filed according the restriction requirement, over this application. No double patenting rejection would be available and the term of subsequent divisional applications may be longer than the present application due to, for example, patent term extensions. Applicant expressly takes no position on whether the groups of claims are patentably independent or distinct from one another.

Reconsideration and withdrawal of the Restriction Requirement are respectfully requested and all claims be continued to be examined.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP

By: 

Jean-Paul Hoffman

Reg. No.: 42,663

Tel. No.: (703) 770-7794

Fax No.: (703) 770-7901

P.O. Box 10500
McLean, VA 22102
(703) 770-7900